

REMARKS

In the Office action, the examiner rejected only one claim, independent claim 25. Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bawolek in view of Seok.

Bawolek does not disclose the use of a detector for detecting the on/off state of a light source.

See Paper No. 01092006, page 3. Because Seok has nothing to do with microscopes or the detection of the on/off state of a light source, Seok does not cure the deficiency of Bawolek.

Seok deals with refrigerators; therefore, Seok is nonanalogous art. Although a reference may be relied on if it is not in the field of the applicant's endeavor, the reference must be reasonably pertinent to the particular problem with which the inventor was concerned, and a person with ordinary skill would have to reasonably be motivated to go to the field in which the reference was found to solve the problem confronting the inventor. *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1445 (Fed. Cir. 1992), 1446. This requires using common sense to decide which fields a person of ordinary skill would reasonably be expected to look for a solution. *Id.* Moreover, the prior art must provide the reason, suggestion, or motivation for a skilled artisan in one field of invention to make a combination with elements from a nonanalogous source. The knowledge cannot come from the applicant's invention. *Id.* at 1446.

In *Oetiker* the Court reversed the Board's holding that claims rejected under section 103(a) were unpatentable. *Id.* Namely, the Court reversed because the patent Office had not shown that a person of ordinary skill seeking to solve a problem in *Oetiker's* field of invention (e.g., hose clamps) would reasonably be expected or motivated to look to another field of invention (e.g., fasteners for garments). *Id.* Thus, even though *Oetiker's* invention had a hook and the cited art also had hooks (and eye fasteners), this was not enough to provide a suggestion or motivation to combine nonanalogous art. In other words, not all hooking problems are necessarily analogous. *Id.* at 1445.

Similarly, the examiner of this application has not shown that there is a suggestion or motivation in *the prior art* that would cause one of ordinary skill in the microscopic arts to look to the refrigeration arts to make a combination. The examiner reasons that it would have been obvious to one skilled in the art to use a detecting system having a detector for detecting whether a light source is ON or OFF for the purpose of informing a user of the ON or OFF status of the light source which would avoid user confusion. Paper No. 01092006, pages 5-6. But a user of Bawolek would not be confused as to which light source he or she selected. For example,

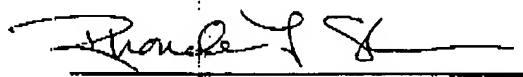
referring to Figure 3, Bawolek's interface is designed to assist a user in selecting a light source. Specifically, the user may select an infrared light source by selecting icon 78 or select a visible light source by selecting icon 80. There is no confusion whatsoever as to which light source the user is selecting to illuminate an object with.

Additionally Seok's goal is to avoid a time delay between opening a refrigerator door and turning on the refrigerator's interior light. *See, e.g.*, column 1. Toward this end, Seok detects when a user touches a sensor on a refrigerator door handle or opens the refrigerator door. *See, e.g.*, Figure 5. Seok does not detect the on or off state of a light and then, based on that determination, take an action. That the refrigerator's lamp may be on or off is incidental to the other events. Moreover, it is common knowledge that a refrigerator light comes on when the refrigerator door is opened and the light goes off when the door is closed. The user does not need a detector to know this or to avoid being confused as to the on or off status of the light. Thus, it is submitted that the examiner has reconstructed the applicant's invention only with the benefit of inappropriate hindsight reasoning by combining the elements of nonanalogous sources. This is exactly what the *Oetiker* Court in warns against. *Oetiker*, at 1445-1446.

Because Seok does not specifically seek to detect the status of a light source and because there is no common sense reason for a person looking at the problem to be solved in the applicant's field of endeavor to look to Seok, it is respectfully submitted that *prima facie* obviousness has not been established. Reconsideration of the rejection is requested. As the application is in condition for allowance the examiner's prompt action in accordance therewith is requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.04 | 5D1US).

Respectfully submitted,

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